

REMARKS

Claims 1, 2, 8-11, 16, 17, 19-21, 34-36, 39-42, 44-48, 50, 52, and 54-68 are pending in the application. Claims 5, 7, 15, 23-32, 49, and 53 have been canceled, and claims 54-68 have been added. Support for the new claims can be found, e.g., in original claims 1, 2, 4-7, and in the specification at, e.g., page 3, line 4, to page 4, line 23. These amendments add no new matter.

Allowed Claims

Applicants acknowledge the Examiner's conclusion at pages 1 and 7 of the Office Action that claims 1, 2, 8-11, 16, 17, 19-21, 34-36, 39-42, 44-48, 50, and 52 are allowed. As detailed herein, the rejected claims have been canceled. In addition, new claims 54-68 have been added.

Objection to the Specification

At pages 2-3 of the Office Action, the Examiner objected to the amendment filed on October 28, 2002 as allegedly introducing new matter into the disclosure. For the reasons provided below, applicants respectfully submit that the requested amendment does not contain new matter.

The specification discloses the sequence of a "Serine Protease Inhibitor-Growth Hormone Response Element" (abbreviated SPI-GHRE) having the sequence GATCTACGCTTCTACTAATCCATGTTCTGAGAAATCATCCAGTCTGCCATG (SEQ ID NO:1). The actual sequence of the "SPI-GHRE" is identically disclosed at two locations on page 2 of the specification (lines 16-17 and lines 33-34). In each case, the disclosed sequence is 52 base pairs in length. However, on pages 2 and 3 of the specification, the "SPI-GHRE" is referred to as the "50 bp SPI-GHRE." The proposed amendments to the specification amend the phrase "50 bp" to "52 bp."

An amendment to correct an obvious error in a specification does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also the appropriate correction. In re Oda, 443 F.2d 1200 (CCPA 1971) and MPEP § 2163.07. In the present case, applicants respectfully submit that a person of ordinary skill in the biological arts would recognize both the existence of the error described above, as

well as its appropriate correction. First, the skilled biologist would recognize the existence of the error, since page 2 specification discloses the 52 base pair sequence of the "SPI-GHRE" (lines 16-17), but later on the same page refers to it as the "50 bp SPI-GHRE" (line 32), which disclosure is then immediately followed by the 52 base pair sequence of the "SPI-GHRE" (lines 32-34). Second, the skilled biologist would recognize the appropriate correction, since both of the specification's disclosures of the actual sequence of the "SPI-GHRE" are of a 52 base pair sequence. The skilled biologist would expect that the reference to the disclosed 52 base pair sequence as "the 50 bp SPI-GHRE" was merely a mischaracterization or an approximation of the length of the actual, disclosed sequence. The skilled biologist would not expect that the discrepancy resulted from applicants' inclusion of an incorrect (and inappropriately long) sequence for the "SPI-GHRE." Accordingly, the skilled biologist would understand the appropriateness of correcting the "50 bp" to read "52 bp" as requested in the earlier-filed amendment.

In light of these comments, applicants respectfully submit that the specification contains an obvious error, the correction of which does not introduce new matter into the disclosure. Accordingly, applicants request that the Examiner withdraw the objection.

35 U.S.C. §112, First Paragraph

At page 4 of the Office Action, the Examiner rejected claim 31 as allegedly containing new matter. Claim 31 has been canceled, thereby obviating the rejection.

35 U.S.C. §112, Second Paragraph

At pages 4-5 of the Office Action, the Examiner rejected claim 49 as allegedly indefinite. Claim 49 has been canceled, thereby obviating the rejection.

35 U.S.C. §102(b)

At pages 5-6 of the Office Action, the Examiner rejected claims 27-32 as allegedly anticipated by Yoon et al. (1990) J. Biol. Chem. 265:19947-54. Claims 27-32 have been canceled, thereby obviating the rejection.

Applicant : Gunnar Norstedt et al.
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35 U.S.C. §102(e)

At page 6 of the Office Action, the Examiner rejected claims 5, 7, 15, 23-26, and 53 as allegedly anticipated by Seidel et al., U.S. Patent No. 5,814,517. Claims 5, 7, 15, 23-26, and 53 have been canceled, thereby obviating the rejection.